

REMARKS

Claims 1-27 are pending in the application.

Claims 1-27 have been rejected.

Claims 1, 13, 24, 25 and 27 have been amended, as set forth herein.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-6, 9-19 and 21-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Friedes et al. (US 5,311,572). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Applicant has amended independent Claims 1, 13, 24, 25 and 27 to recite that the claimed invention operates within, or over, a packet-switched communications network. In contrast, the Friedes reference describes calls routed through a conventional, circuit-switched telephone network, as illustrated by toll switches 110-112 of Figure 1 and described in column 7, lines 16-29. What the Friedes reference refers to as the routing process is, in fact, the process of choosing a destination telephone number. See Friedes, column 15, line 68, to column 16, line 4, and column

16, lines 29-32. Once the destination number is chosen, the call is then sent through the circuit-switched network of toll switches 110-112, LEC switch 121 and PBXs 115 and 116. The call path through the network is determined by the digits of the chosen destination telephone number, as in the description of prior art circuit-switched telecommunications systems found in Applicant's Specification, page 1, line 11, to page 2, line 14. The Applicant respectfully asserts that the Friedes reference does not teach route selection in a packet-switched network. Accordingly, Friedes does not show each and every feature/element of the Applicant's claimed invention, arranged as they are in independent Claims 1, 13, 24, 25 and 27 (and dependent claims).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-6, 9-19 and 21-27.

II. REJECTION UNDER 35 U.S.C. § 103

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedes et al. (US 5,311,572) in view of Lehmacher et al. (US 6,343,123). Claims 8 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedes in view of Gudjonsson et al. (US 6,564,261). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claim 7 depends from amended independent Claim 1 and incorporates the features/elements therein recited. Similar to the Friedes reference, the Lehmacher reference describes a conventional

circuit-switched telecommunications systems. See Lehmacher, column 3, line 57, to column 4, line 17. Thus, for the same reasons given above with respect to the §102 rejection of amended independent Claim 1, Friedes and Lehmacher, either alone or in combination, fail to disclose, teach or suggest all the features/elements of dependent Claim 7. Therefore, a prima facie case of obviousness has not been established.

With respect to Claims 8 and 20, the Office Action asserts that Gudjonsson (at column 35, lines 13-18) teaches that the called alias is a Uniform Resource Locator (URL). The Applicant respectfully asserts that the Office Action mischaracterizes the teaching of the Gudjonsson reference. The cited passage describes an address book storing various pieces of information about each user of a system, including such descriptive information as the user's interests and home page URL. The Gudjonsson reference does not teach using the URL as a called alias for the user, as recited in Claims 8 and 20. Thus, Claims 8 and 20 recite features/elements that are not disclosed, taught, or suggested by Friedes and Gudjonsson.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 7, 8 and 20.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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